REMARKS/ARGUMENTS

Applicants conducted an interview with the Examiner and are placing the claims in a condition for allowance

Applicants conducted an interview with the Examiner on March 29, 2005 and the Examiner after consultation with his supervisor indicated that claims 7, 22, 37, 46, 48, 50 are likely to be patentable. The Examiner also indicated that if likely to be allowed claim 22 is rewritten in independent form, then claim 21 (on which likely to be allowed claim 22 depends) could depend from independent claim 16.

Applicants have canceled the independent claims 1, 16, 31, and rewritten likely to be allowed claims 7, 22, 37, 46, 48, 50 in independent form including requirements of the base claim and any intervening claims. While rewriting claim 22 in independent form, Applicants have included the requirements of canceled independent claim 16 and the requirements of claim 21, with claim 21 assumed to depend on the canceled independent claim 16.

All other non-canceled claims depend directly or indirectly on the likely to be allowed independent claims 7, 22, 37, 46, 48, 50.

Applicants submit that the non-canceled claims are in a condition for allowance.

Amendments to the specification

A few reference numeral errors in the specification have been amended to make the reference numerals indicated in the specification correspond to the reference numerals indicated in the previously presented drawings. No new matter has been added.

Amended Independent claims 7, 22, 37

Claim 7 has been rewritten in independent form to include the requirements of claim 1 and claim 6. Claim 22 has been rewritten in independent form to include the requirements of

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claim 16 and claim 21 where claim 21 depends on claim 16 instead of 19. Claim 37 has been rewritten in independent form to include the requirements of claims 31 and 36.

Independent claims 7, 22, 37 require configuring a client computer connected to a network, wherein a remote computer is capable of communicating with the client computer over the network, comprising:

storing sets of configuration parameters in a non-volatile storage unit, wherein the sets of configuration parameters instruct at least one program how to initialize operational parameters and load programs into the client computer memory during a power on;

for each set of configuration parameters, storing a token in the non-volatile storage unit indicating access rights to the set of configuration parameters, wherein the token specifies whether management entities running on the remote computer and client computer can access the set of configuration parameters for that token, and wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters;

launching a configuration program from a removable storage unit interfaced with the client computer, wherein the configuration program is used to modify sets of configuration parameters in the non-volatile storage unit;

launching a setup program from the removable storage unit during a power on when the client computer has not previously been configured;

receiving settings for at least one set of configuration parameters via the setup program; and

storing the received settings in the non-volatile storage unit, wherein the configuration program is launched to provide an interface to allow a user to set configuration parameters for other sets of configuration parameters.

The Examiner has rejected claims 7, 37 under 35 U.S.C 103(a) as being unpatentable over Arrouye (US 6,256,635), in view of Hunnicutt (US 5,889,952), in view of Bourke (US

6,449,642), in view of Bahlmann (US 6,170,008). The Examiner has rejected claim 22 under 35 U.S.C 103(a) as being unpatentable over Arrouye, in view of Hunnicutt, in view of Bahlmann, in view of Bourke, and in view of Nishiyama (US 5,778,365). Applicants traverse.

The cited Bahlmann does not teach the claim requirement of "wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters.

In the cited Bahlmann the server stores server configuration information. The server uses parameters (such as network specific parameters and client specific parameters) decoded from the TFTP request and the server configuration information to build the boot file. Therefore, in the cited Bahlmann the server uses client provided information (the parameters provided by the TFTP request) and server configuration information to build the boot file. The cited Bahlmann discusses that the parameters from the server configuration information may include default values common to all clients, common to all device types of a specific vendor, or common to other factors. Therefore, in the cited Bahlmann one set of configuration information is in the server and the other set is in a client and sent by the client.

The claims require:

(a) the sets of configuration parameters to be stored in the non-volatile storage unit

(b) the sets of configuration parameters to be overlapping

(c) a first management entity on the remote computer and a second management entity on the client computer being able to configure a same set of configuration parameters.

The teachings of the cited Bahlmann are different because:

(a) In the cited Bahlmann the server configuration information is in the server and the configuration information in the TFTP request is in the client and comes from the client.

(B) The sender of the TFTP request does not configure the server configuration parameters stored in the server. whereas the claims require that "a first management entity on the remote computer

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and a second management entity on the client computer being able to configure a same set of configuration parameters", that "are stored in the non-volatile storage unit."

Additionally, the recent U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") decision in In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002) is particularly instructive as to why the Examiner's proposed combination of 'Arrouye, Hunnicutt, Bahlmann, and Bourke', or 'Arrouye, Hunnicutt, Bahlmann, Bourke and Nishiyama' is improper. In Lee, the Federal Circuit emphasized that it is essential that the decision to combine references "must be based on objective evidence of record". Id. at 1433. The Federal Circuit said that authority is required and cannot be substituted with "'[c]ommon knowledge and common sense,' even if assumed to derive from the agency's expertise." Id. 1435. The Federal Circuit said that this means that the Examiner cannot rely on conclusory statements of motivation. Id. at 1434. ("Conclusory statements such as those here provided do not fulfill the agency's obligation").

Under Lee, the Examiner's motivation is conclusory because the Examiner has not explained how it would be obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Bahlmann within the combination of Arrouye, Bourke, and Hunnicutt (or combine Bahlmann, Arrouye, Bourke, Hunnicutt, Nishiyama) to arrive at the claim requirement of "wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters." The Examiner mentions that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Bahlmann within the combination of Arrouye and Hunnicutt in order to allow configuration of parameters that are overlapping". There is no suggestion or motivation provided for combining the teachings of Bahlmann, Arrouye and Hunnicutt in any of the three references to arrive at the claim requirements. The Examiner's proffered motivation is not supported by objective evidence and appears to be based on "common knowledge", which under Lee is improper.

Applicants further submit that the Examiner is engaging in inappropriate use of hindsight in combining the cited Arrouye, Hunnicutt, Bahlmann and Bourke, or combining the cited Arrouye, Hunnicutt, Bahlmann, Bourke, and Nishiyama. The Federal Circuit has made clear that some objective teaching of the suggestion or motivation to combine prior art references is needed. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Here, the Examiner is engaging in improper use of hindsight to justify the proposed modification because the Examiner has not provided any objective teaching to support the proposed combination and modification. The Examiner's motivation for the combination or modification comes from the claim language itself which uses the term " sets of configuration parameters are overlapping" and not any objective evidence.

Still further, case law is very clear that just because one can readily modify the prior art to produce the claimed combination does not make the claimed combination obvious unless the Examiner can provide some objective reference teaching or suggesting the claimed combination. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even modifications that may appear simple cannot be made unless the Examiner provides suggestion or motivation to make the apparent "simple" modification. According to the Federal Circuit,

> In a proper obviousness determination, "[w]hether the changes from the prior art are 'minor', . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's . . . device." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir.), cert. denied, 498 U.S. 920 (1990). This includes what could be characterized as simple changes, as in In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).

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In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

      Here, the Examiner has not offered any objective evidence of a suggestion or motivation in the art to combine the teachings or modify the cited Arrouye, Hunnicutt or Bahlmann, and Bourke (and also Nishiyama) to arrive at the claims requirements of "wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters." The fact that combination of Arrouye, Hunnicutt, Bahlmann, Bourke and Nishiyama is generally desirable is not sufficient to justify the Examiner's proposed combination.

      Additionally, neither the cited Arrouye, Hunnicutt, Bourke, Bahlmann, Nishiyama teach or suggest the claim requirement storing the received settings in the non-volatile storage unit, wherein the configuration program is launched to provide an interface to allow the user to set configuration parameters for other sets of configuration parameters.

      The configuration program of the cited Arrouye is different from the setup program of the claims requirements, because the setup program of the claim requirements additionally run when the client computer has not been previously configured and during power on. Neither the cited Hunnicutt, Bourke, Bahlmann, Nishiyama teach the setup program of the claim requirement either.

      For the above reasons claims 7, 22, 37 are patentable over the cited art.

Amended Independent Claims 46, 48, 50

      Claims 46, 48, 50 have been rewritten in independent form including the requirements of the base claim and any intervening claims on which claims 46, 48, 50 depended.

      Amended independent claim 46, 48, 50 requires configuring a client computer connected to a network, wherein a remote computer is capable of communicating with the client computer over the network, comprising:

storing sets of configuration parameters in a non-volatile storage unit, wherein the sets of configuration parameters instruct at least one program how to initialize operational parameters and load programs into the client computer memory during a power on;

for each set of configuration parameters, storing a token in the non-volatile storage unit indicating access rights to the set of configuration parameters, wherein the token specifies whether management entities running on the remote computer and client computer can access the set of configuration parameters for that token, and wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters, wherein each token specifies at least one management entity, wherein only the management entity specified in the token has access rights to the set of configuration parameters associated with that token, wherein at least one token specifies one management entity at the client computer and at least one other token specifies one management entity at the remote computer, and wherein a first user at the client computer and a second user at the remote computer are both capable of changing access settings indicated in the token to exclude other users from access to corresponding configuration parameters of the token.

The Examiner has rejected claims 46, 48, 50 under 35 U.S.C 103(a) as being unpatentable over Arrouye (US 6,256,635), in view of Hunnicutt (US 5,889,952) and Bahlmann (US 6,170,008). Applicants traverse.

The cited Bahlmann does not teach the claim requirement of "wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters.

In the cited Bahlmann the server stores server configuration information. The server uses parameters (such as network specific parameters and client specific parameters) decoded from the TFTP request and the server configuration information to build the boot file. Therefore, in the cited Bahlmann the server uses client provided information (the parameters provided by the

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TFTP request) and server configuration information to build the boot file. The cited Bahlmann discusses that the parameters from the server configuration information may include default values common to all clients, common to all device types of a specific vendor, or common to other factors. Therefore, in the cited Bahlmann one set of configuration information is in the server and the other set is in a client and sent by the client.

The claims require:

(a) the sets of configuration parameters to be stored in the non-volatile storage unit

(b) the sets of configuration parameters to be overlapping

(c) a first management entity on the remote computer and a second management entity on the client computer being able to configure a same set of configuration parameters.

The teachings of the cited Bahlmann are different because:

(a) In the cited Bahlmann the server configuration information is in the server and the configuration information in the TFTP request is in the client and comes from the client.

(B) The sender of the TFTP request does not configure the server configuration parameters stored in the server. whereas the claims require that "a first management entity on the remote computer and a second management entity on the client computer being able to configure a same set of configuration parameters", that "are stored in the non-volatile storage unit."

Additionally, the recent U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") decision in In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002) is particularly instructive as to why the Examiner's proposed combination of Arrouye, Hunnicutt, Bahlmann, and Bourke is improper. In Lee, the Federal Circuit emphasized that it is essential that the decision to combine references "must be based on objective evidence of record". Id. at 1433. The Federal Circuit said that authority is required and cannot be substituted with "'[c]ommon knowledge and common sense,' even if assumed to derive from the agency's expertise." Id. 1435. The Federal Circuit said that this means that the Examiner cannot rely on conclusory statements of motivation. Id. at 1434. ("Conclusory statements such as those here provided do not fulfill the agency's obligation").

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Under Lee, the Examiner's motivation is conclusory because the Examiner has not explained how it would be obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Bahlmann within the combination of Arrouye, Bourke, and Hunnicutt to arrive at the claim requirement of "wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters." The Examiner mentions that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Bahlmann within the combination of Arrouye and Hunnicutt in order to allow configuration of parameters that are overlapping". There is no suggestion or motivation provided for combining the teachings of Bahlmann, Arrouye and Hunnicutt in any of the three references to arrive at the claim requirements. The Examiner's proffered motivation is not supported by objective evidence and appears to be based on "common knowledge", which under Lee is improper.

Applicants further submit that the Examiner is engaging in inappropriate use of hindsight in combining the cited Arrouye, Hunnicutt, Bahlmann and Bourke. The Federal Circuit has made clear that some objective teaching of the suggestion or motivation to combine prior art references is needed. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.") Here, the Examiner is engaging in improper use of hindsight to justify the proposed modification because the Examiner has not provided any objective teaching to support the proposed combination and modification. The Examiner's motivation for the combination or modification comes from the claim language itself which uses the term " sets of configuration parameters are overlapping" and not any objective evidence.

Still further, case law is very clear that just because one can readily modify the prior art to produce the claimed combination does not make the claimed combination obvious unless the Examiner can provide some objective reference teaching or suggesting the claimed combination.

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"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even modifications that may appear simple cannot be made unless the Examiner provides suggestion or motivation to make the apparent "simple" modification. According to the Federal Circuit,

> In a proper obviousness determination, "[w]hether the changes from the prior art are 'minor', . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's . . . device." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir.), cert. denied, 498 U.S. 920 (1990). This includes what could be characterized as simple changes, as in In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).

In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

Here, the Examiner has not offered any objective evidence of a suggestion or motivation in the art to combine the teachings or modify the cited Arrouye, Hunnicutt or Bahlmann to arrive at the claims requirements of "wherein if the sets of configuration parameters are overlapping then a first management entity running on the remote computer and a second management entity running on the client computer can configure a same set of configuration parameters." The fact that combination of Arrouye, Hunnicutt and Bahlmann is generally desirable is not sufficient to justify the Examiner's proposed combination.

The cited Hunnicutt discusses tokens used by users to access files. The Examiner modifies the tokens discussed in the cited Hunnicutt to be used in the client and remote computers of the cited Arrouye to arrive at the claimed combination. While there is no suggestion or motivation in the cited Hunnicutt or the cited Arrouye for the claimed combination, the Examiner provides that one of ordinary skill in the art would have realized that entities at a client computer and remote computer for configuration purposes would need tokens for access to

configuration files. The motivation is improper and uses hindsight. The tokens of the cited Hunnicutt are designed for use on a device used by multiple clients (Hunnicutt: FIG. 1). To modify this tokens to be to arrive at the claim requirement that at least one token specifies one management entity at the client computer and at least one other token specifies one management entity at the remote computer is not obvious. A person of ordinary skill in the art would implement the token based system of the cited Hunnicutt twice - once for the client computer and separately for the remote computer. There is no proper motivation to arrive at the combination as required by the claims, where at least one token specifies one management entity at the client computer and at least one other token specifies one management entity at the remote computer.

Dependent claims 2-6, 8-15, 17-21, 23-30, 32-36, 38-45, 47, 49, 51

Applicants submit that dependent claims 2-6, 8-15, 17-21, 23-30, 32-36, 38-45, 47, 49, 51 are patentable over the cited art because they depend from independent claims 7, 22, 37, 46, 48 or 50 which are patentable over the cited art for the reason discussed above, and because the combination of the limitations in the dependent claims 2-6, 8-15, 17-21, 23-30, 32-36, 38-45, 47, 49, 51 and the base and intervening claims from which they depend provide further grounds of distinction over the cited art.

Conclusion

For all the above reasons, Applicant submits that the pending claims are patentable over the art of record. Should any additional fees beyond those indicated be required, please charge Deposit Account No. 50-0585.

The attorney/agent invites the Examiner to contact him at (310) 557-2292 if the Examiner believes such contact would advance the prosecution of the case.

Dated: April 11, 2004

By: _____

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Please direct all correspondences to:

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